

App. Serial No: 09/350,952
Atty Dkt: 99-803

REMARKS

This Response is filed in reply to the Office Action dated October 12, 2004. In this Response, Applicant traverses the Examiner's rejections of claims 20-33 and 35-43. Silence with regard to any of the Examiner's rejections is not acquiescence to such rejections. Specifically, silence with regard to Examiner's rejection of a dependent claim, when such claim depends from an independent claim that Applicant considers allowable for reasons provided herein, is not an acquiescence to such rejection of the dependent claim(s), but rather a recognition by Applicant that such previously lodged rejection is moot based on Applicant's remarks and/or amendments relative to the independent claim (that Applicant considers allowable) from which the dependent claim(s) depends.

By the foregoing amendments, Applicant has revised independent claim 20 to replace the wording "providing" with "electronically generating", and the wording "responding to" with "electronically servicing" to make it clear that Applicant's method, as described in independent claim 20, is performed by the application of a technological art, and to thereby overcome the Examiner's rejection of claim 20 under 35 U.S.C. § 101. Support for the amended wording may be found throughout the application, including, for example, at the paragraph beginning at line 24 of page 19, and ending at line 9 of page 20 of the originally filed application. Additionally, Applicant has further revised independent claim 20 to more clearly indicate that the feature of electronically servicing selection of objects is performed in accordance with information (namely, the at least one ordering method and payment method) contained within the electronic catalog. Further, the Applicant has replaced the word "providing" in the preamble of claim 20, and in claims 27, 29, 31, and 33 with the word "processing" to make it more clear that Applicant's method is performed by application of a technological art. After these amendments, claims 20-33 and 35-43 are pending.

The Examiner rejected claims 20-23, 26, 28, 30, 32, 41 under U.S.C. 103(a) as being unpatentable over Lambert et al. (U.S. Patent No. 6,038,601), in view of Perkowski (U.S. Patent No. 5,950,173), and further in view of Dana Mackenzie (which Applicant assumes is the reference "New language could meld the Web into a seamless database" by Mackenzie).

App. Serial No. 09/350,952

Atty Dkt: 99-803

Examiner also rejected claims 24, 25, 27, 29, 31, 33, 35-40, and 42-43 as being unpatentable over Lambert in view of Perkowski and Dana Mackenzie, and further in view of other references relied upon by the Examiner. Applicant respectfully requests that the Examiner reconsider this rejection.

As Examiner knows, and based at least on MPEP 2143, a *prima facie* case of obviousness under 35 U.S.C. 103(a) requires (1) a suggestion or motivation in the references themselves or generally known in the art, to combine the references, (2) a reasonable expectation of success to combine, and (3) *a teaching, via the combination, of all the claimed limitations* [emphasis added].

Applicant's amended independent claim 20 discloses a method for performing an electronic transaction using an electronic catalog document that contains information about the item(s) to be purchased (or sold), as well as information about the selling party, payment methods, etc. The electronic document also includes verifying content that is used to authenticate the electronic document and thus provides a level of security for the consummation of the prospective electronic transaction. Applicant's electronic catalog is thus a self-containing document that facilitates the completion of an e-commerce transaction without the need to establish a connection between a prospective purchasing party and the seller to obtain some, or all, of the information required for processing the transaction. Applicant's independent claim 20 thus discloses a computer-based method for processing a verifiable electronic catalog, comprising electronically generating sourcing information for a source of the electronic catalog and at least one of ordering method information and payment method information in a header section of the electronic catalog, electronically generating object entries in a body section of the electronic catalog, the object entries corresponding to objects available for at least one of sale by and purchase by the source of the electronic catalog, electronically generating information for verifying content of the header and body sections in a footer section of the electronic catalog, electronically servicing requests for verification of the content based on the sourcing information and the information for verifying content, and *electronically servicing selection of objects for at least one of sale by and purchase by a user in accordance with the at least one ordering method information and payment method information contained in the verifiable electronic catalog.*

App. Serial No. 09/350,952
Atty Dkt: 99-803

By contrast, the prior art cited by the Examiner does not describe a self-containing electronic document that includes the information required to process a transaction with respect to an item identified in the document, and therefore does not disclose *electronically servicing selection of objects for at least one of sale by and purchase by a user in accordance with the at least one ordering method information and payment method information contained in the verifiable electronic catalog.*

In particular, Lambert describes a method and apparatus for storing and delivering information over the Internet whereby content providers can periodically send updated content to users who previously accessed and obtained content from those providers. As the Examiner himself acknowledged, Lambert does not relate to methods and apparatus for performing e-commerce, and does not disclose or contemplate using a portable electronic catalog document that can be delivered to prospective purchases, and which contains the data needed to effect an e-commerce transaction. The only reference Lambert makes to any sort of catalog is that of a Table of Content (TOC) catalog, which is a list of groups of data content that facilitates administration of Lambert's content providers' websites, and is not the same as Applicant's self-containing electronic catalog document. So Lambert does not deal with processing e-commerce transactions, and certainly not with anything like Applicant's electronic catalog, and therefore Lambert does not disclose *electronically servicing selection of objects for at least one of sale by and purchase by a user in accordance with the at least one ordering method information and payment method information contained in the verifiable electronic catalog.*

Perkowski, in contrast to Applicant's independent claim 20, teaches a system and method to maintain and manage a database containing records corresponding to a multitude of various products for which web-based information exists on a public network such as the Internet. Users may search for product information by specifying a Universal Product Code (UPC) number. An Internet Product Finding Directory (IPD) server then checks an associated database maintained by the IPD server, to see whether there is a record(s) corresponding to the specified UPC number (col. 18, lines 33-65, and col. 22, lines 23-43). If a record exists, the URL in the record is then sent to the user's workstation, or alternatively, the IPD server can use the URL to access the web-site and forward the product information to the user's workstation (col. 23, lines 56-65; col. 24, lines 1-13). Alternatively, users may also search for product information by specifying a

App. Serial No. 09/350,952
Atty Dkt: 99-803

company name, or a trademark, whereupon the IPD server conducts a search of its database to locate the records, and by extension, the products, corresponding to the specified company name or trademark (col. 23, lines 7-39).

While Perkowski teaches that a user can purchase a product found through the searches performed by the IPD server, such transactions are conducted through traditional Electronic Data Interchange (EDI) that involve establishing network connections between EDI compatible systems, and exchanging documents to effect the transaction (see, for example, col. 10's line 66, to col. 11's line 5). Perkowski neither describes nor suggests that e-commerce transactions are effectuated using electronic catalog document containing, among other things, a list of the items to be purchased and the information needed to complete the transaction, and thus does not disclose *electronically servicing selection of objects for at least one of sale by and purchase by a user in accordance with the at least one ordering method information and payment method information contained in the verifiable electronic catalog.*

As for Mackenzie, this reference provides a general description of the advantages of XML, and/or other similar marked-up languages, and notes that XML can use tags to identify or annotate data, and that computer applications reading XML documents can then act on the information conveyed by the tags to more efficiently handle and process the XML documents (see, for example, the paragraph beginning with the wording "by, contrast, XML allows ..."). But nowhere does Mackenzie teach performing electronic commercial transactions, and certainly does not describe performing such transactions using electronic catalogs by *electronically servicing selection of objects for at least one of sale by and purchase by a user in accordance with the at least one ordering method information and payment method information contained in the verifiable electronic catalog.*

Accordingly, since the combined teaching of Lambert, Perkowski, and Mackenzie does not teach *electronically servicing selection of objects for at least one of sale by and purchase by a user in accordance with the at least one ordering method information and payment method information contained in the verifiable electronic catalog*, as recited in Applicant's independent claim 20, the Examiner failed to provide a *prima facie* case of obviousness for failing to show all the elements of the claimed invention in the combined teaching cited by the Examiner, as

App. Serial No. 09/350,952
Atty Dkt: 99-803

required by MPEP 2143. Applicant thus traverses Examiner's 35 U.S.C. 103(a) rejection of independent claim 20, and considers independent claim 20 to be allowable. Claims 21-33, and 35-43 are also allowable as depending from an allowable base claim.

Accordingly, Applicant asks that the Examiner reconsider and allow claims 20-33, and 35-43.

CONCLUSION

In view of the foregoing remarks, Applicant submits that the response herein is fully responsive to the subject Office Action, and that the pending claims are patentable over the cited prior art. Accordingly, Applicant submits that the claims are now in condition for allowance. Withdrawal of the pending rejections, and early and favorable reconsideration are respectfully solicited. If there are any remaining issues or the Examiner believes that a telephone conversation with Applicant's attorney would be helpful in expediting the prosecution of this application, the Examiner is invited to call the undersigned at (972) 718-4800.

Respectfully submitted,



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